

Response Under 37 CFR §1.116

Expedited Procedure

Examining Group 3724

Application No. 10/538,545

Paper Dated: October 17, 2008

In Reply to USPTO Correspondence of July 18, 2008

Attorney Docket No. 3135-051782

REMARKS

This Amendment is responsive to the July 18, 2008 Office Action. In the Office Action, claims 18-31 stand rejected and claims 35-37 have been withdrawn. Claim 25 has been amended to incorporate the subject matter of dependent claim 28 and a portion of dependent claim 27. Claims 28 and 37 have been cancelled. Claim 27 has been amended to delete the subject matter incorporated into claim 25. Claims 18-27, 29-31, 35 and 36 are now pending.

Restriction Requirement

The Examiner asserts that newly added claims 35-37 are directed to an invention that is independent or distinct from the invention originally claimed. In particular, the Examiner asserts that claims 29 and 35-37 are related as subcombinations that do not overlap in scope, are not obvious variants, and at least one subcombination is separately usable from the other. The Examiner has withdrawn claims 35-37 from consideration.

Applicants respectfully submit that the restriction between claims 29 and 35-37 is improper. A combination is an organization of which a subcombination or element is a part. MPEP § 806.05(a). Claim 29 and newly added claims 35-37 depend from independent claim 25 and include all the limitations thereof. Thus, claims 29 and 35-37 are not separately claimed as subcombinations, but rather further define the punching machine of claim 25. Claim 37 has been cancelled. Therefore, reconsideration and withdrawal of the restriction with respect to claims 35 and 36 are respectfully requested.

Rejections Under 35 U.S.C. §102 and 35 U.S.C. §103

Claims 18-30 stand rejected under 35 U.S.C. § 102(b) for anticipation by U.S. Patent Application Publication No. 2001/0020409 to Hashimoto et al. Claims 29-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashimoto in view of JP 07-132497 to Isamu. In view of the foregoing amendment and the following comments, reconsideration of these rejections is respectfully requested.

Independent claim 18 recites, *inter alia*, "wherein the cutting opening functions during the return stroke such that the side of the cutting plate remote from the sheet

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material engages around the cutting opening as a scraping edge on the slug adhering to the stamp and releases it from the stamp.”

The Hashimoto reference fails to disclose or suggest where the cutting opening functions during the return stroke such that the side of the cutting plate remote from the sheet material engages around the cutting opening as a scraping edge on the slug adhering to the stamp and releases it from the stamp as recited in claim 18. In contrast, the Hashimoto reference discloses that a fragment of the workpiece sticking to the punch (2) may be removed by using an edge portion of the gate (13b) when the punch is moved up and down in the punching operation as opposed to using the cutting edge portion (3a) of Hashimoto to scrape the fragment off the punch (2) (see paragraph [0049]). The diameter of the undercut portion (3b) disposed under the lower portion of the cutting edge portion (3a) is slightly larger than the diameter of the bore to permit a chad “to freely drop out of the undercut portion 3b” (paragraph [0064]). Thus, in contrast to the position asserted at page 5 of the Office Action, the cutting edge portion (3a) of Hashimoto does not function as a scraping edge on the slug adhering to the stamp to release it from the stamp as recited in claim 18.

Further, the Hashimoto reference states that the punch (2) may perform its lost motion to “remove the fragment of the soft metal sheet having stuck to the punch (2) by using the upper and the lower edge of the gate (13b)” (see paragraph [0070]). For instance, Hashimoto states that “the punch 2 performs its lost motion three times to remove the fragment of the soft metal sheet having stuck to the punch 2 ...” (paragraph [0070]). Thus, the “lost motion” feature of Hashimoto also utilizes the edge portions of the gate (13b) as opposed to a cutting opening and also functions during “lost motion” of the punch rather than during the return stroke of the stamp. Therefore, for at least the foregoing reasons, the Hashimoto reference fails to disclose all of the limitations of independent claim 18.

Dependent claim 19 recites “wherein the stamp is carried through the cutting opening in the cutting plate during the punching operation such that the periphery of the slug adhering to the stamp is released over only a part of the periphery from the cutting plate.”

The Hashimoto reference fails to disclose or suggest a method for releasing a slug adhering to a stamp in a punching machine where the stamp is carried through the

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cutting opening in the cutting plate during the punching operation such that the periphery of the slug adhering to the stamp is released over only a part of the periphery from the cutting plate as recited in claim 19. In contrast, as discussed above, the Hashimoto reference discloses that a fragment of the workpiece sticking to the punch (2) may be removed by using an edge portion of the gate (13b) when the punch is moved up and down in the punching operation (see paragraph [0049]). The edge portions of the gate (13b) in Hashimoto, however, are perpendicular to the longitudinal axis of the punch (2) and fail to disclose where the periphery of the slug adhering to the stamp is released over only a part of the periphery from the cutting plate as in the present invention. Therefore, the Hashimoto reference fails to disclose all of the limitations of dependent claim 19.

Independent claim 25 recites, *inter alia*, “wherein the edge of the cutting opening on the side remote from the side supporting the material layer at least locally encloses an angle with a cutting edge of the stamp.”

The Hashimoto reference fails to disclose or suggest a punching machine for releasing a slug adhering to a stamp where the edge of the cutting opening on the side remote from the side supporting the material layer at least locally encloses an angle with a cutting edge of the stamp as recited in independent claim 25. In particular, as shown in Fig. 4, the edge of the cutting opening remote from the side supporting the material layer in Hashimoto is defined by the area where the cutting edge portion (3a) and the undercut portion (3b) are joined. Thus, the edge of the cutting opening (3a) that is remote from the side supporting the material layer, as shown in Fig. 4, does not enclose an angle with a cutting edge of the stamp.

Furthermore, the Hashimoto reference fails to disclose or suggest a cutting opening having a scraping edge as in the present invention and, as discussed above, relies upon the edge portion of the gate (13b) to scrape the fragment off the punch (2) as opposed to the cutting edge portion (3a) (see paragraph [0087]). Thus, the cutting edge portion (3a) does not have a scraping edge for releasing the slug adhering to the stamp as recited in claim 25. Accordingly, the angled portion below the undercut portion (3b) and the angled undercut portion (b) shown in Figs. 4 and 5 of Hashimoto, respectively, also fail to disclose a cutting opening having a scraping edge for releasing the slug adhering to the stamp. Therefore, for at

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least the foregoing reasons, the Hashimoto reference fails to disclose all of the limitations of independent claim 25.

Further, claims 19-24, 26, 27, 29-31, 35 and 36 indirectly or directly depend from and add further limitations to either independent claim 18 or independent claim 25. Thus, claims 19-24, 26, 27, 29-31, 35 and 36 are deemed to be in condition for allowance for all of the reasons set forth hereinabove.

Reconsideration and withdrawal of these rejections are respectfully requested.

Conclusion

In view of the foregoing amendments and comments, Applicants respectfully request reconsideration of the rejections of claims 18-27, 29-31, 35 and 36 and allowance of the same.

Should the Examiner have any questions regarding this information or wish to discuss this matter in further detail to advance prosecution, the Examiner is invited to contact Applicants' undersigned representative by telephone at the number provided below.

Respectfully submitted,

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